

**REMARKS**

As discussed during the Interview, each independent claim now recites the use of “two dimensional (2D) images used in “first” and “second” transaction codes that are optically scanned from a wireless device at two distinct times.<sup>1</sup> The first scan “partially” completes the wireless transaction, and the second scan then completes that transaction. The written description provides several examples of this two-stage scanning operation to complete a single wireless transaction; see, e.g., the “Car Rental” example beginning at page 17, and the “Movie Theater” example beginning at page 23. The first and second transactions code may (or may not) be different codes, but as discussed during the Interview, the use of a 2D image on a mobile device is not disclosed or suggested by the art of record.

The 2D image codes are described at page 14, lines 19-22.

In reviewing amended claims 1 and 47, the Examiner should note that the “first time,” “second time” and “third time” references are temporal (meaning that they relate to points in time during the wireless transaction). The Car Rental example (at page 17) illustrates the support in the specification for this subject matter. In this particular example (and not by way of limitation), the “first time” is when the user “contacts the TMS using his wireless telephone” (page 17, lines 3-4), the “second time” is when the user “arrives at the air port of the city” and “passes the wireless telephone over” the barcode reader (page 17, lines 13-16), and the “third time” is when the user arrives at the car rental lot and the 2D code is scanned “from the visual display of his wireless telephone” (page 17, lines 19-22). Note that the “third time [is] distinct from the first time and the second time” and that these actions “complete the wireless transaction” that was initiated at the “first time.”

As additional §112 support for the amendments, the Examiner is also directed to page 5, line 21 (concerning “partial fulfillment of the transaction request”) and page 25, lines 3-4 (concerning the use of multiple transaction codes”).

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<sup>1</sup> Independent claim 45 has been cancelled simply to reduce the number of issues for the Examiner to address here, given the already lengthy prosecution. The cancellation of this claim is without waiver of any contentions regarding the subject matter of that claim.

As discussed during the Interview, and as further supported by the Declaration of Malik Mamdani filed herewith, one of ordinary skill in the art at the time of this invention (no later than July 13, 2000, when the original provisional application was filed) would not have contemplated use of a 2D image type of transaction code optically scanned from a mobile device. Mr. Mamdani is a co-inventor of the claimed subject matter, and his Declaration addresses the technical and practical reasons that the art taught away from 2D image codes.<sup>2</sup> Before discussing that Declaration, however, the undersigned first addresses the question of Whitworth, U.S. Publication No. 2001/0034717, which the Examiner has relied upon to show that “one of ordinary skill in the art at the time of the invention [would have modified] the device of Lewis and Hymel et al by specifically adding code being a two dimensional code ...” (Office action at pages 13, 17 and 19).

As discussed during the Interview, Whitworth is not prior art. The publication is based on Serial No. 09/764,369, which was filed January 17, 2001, after the filing date of the subject application. Thus, the application Serial No. 09/764,369 itself is not prior art under 35 USC §102(e). Further, although application Serial No. 09/764,369 was based on an earlier provisional application (Serial No. 60/182,626, filed February 15, 2000), the provisional application did not include all of the subject matter that was included in the later-filed utility application. The undersigned has attached a copy of the Whitworth provisional application (Serial No. 60/182,626). As the Examiner will appreciate by comparing Serial No. 60/182,626 to the U.S. Publication 2001/0034717, the utility application includes paragraphs [0128]-[0229] and Figures 8-17 that were not included in the provisional. Thus, with respect to the subject matter in paragraphs [0128]-[0229] and illustrated in Figures 8-17, U.S. Publication No. 2001/0034717 is not entitled to the earlier filing date (February 15, 2000).

For this reason, the Examiner’s combination of Lewis, Hymel and Whitworth cannot stand as a matter of law. Thus, and with respect to claims 26-47, the Examiner has not made out

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<sup>2</sup> The Examiner will note that the 2D code is defined in the amended claims as a code that encodes information “in two dimensions” instead of the “both horizontal and vertical dimensions” wording that was discussed during the Interview. After the Interview, it was determined by the undersigned and the inventor that this wording was more accurate.

a prima facie case of obviousness. For this reason, the Examiner is requested to withdraw the rejections set forth in paragraphs 3-5 of the Office action.

Claims 1-3, 5-25, 30, 34-44, 48-49 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, U.S. Publication No. 2003/0105641, in view of Hymel et al, WO 00/03328. Lewis teaches a system whereby an end user navigates to a web site from his/her desktop computer (Figure 1) or mobile phone (Figure 7), purchases a ticket, and then receives the ticket, possibly in the form of a UPC-type code that can be scanned from at a reader device at a point of entry to the event associated with the ticket. Hymel describes a system whereby a pager device can be used to receive and store UPC-type code that can represent a product coupon. That coupon can be scanned from the pager at the point-of-sale.

Amended claims 1, 30, and 47-48 distinguish over Lewis/Hymel. In the first instance, neither Lewis nor Hymel describe any such concept of a “partial fulfillment” of a wireless transaction. The operating scenarios in those references describe a single pass operation where the mobile device with the one-dimensional code is read and the transaction is over. The amended claims here each recite the multiple 2D image scans that must take place for the “partial” and then “complete” wireless transaction. Because the subject matter “as a whole” must be found in the combination of references, amended claims 1, 30 and 47-48 are patentably distinct over any the Lewis/Hymel combination.

At best, the Lewis/Hymel combination would teach a system whereby an end user navigates to a web site from a mobile phone (Lewis) or pager (Hymel), purchases a ticket, and then receives the ticket in the form of a one-dimensional code that is then scanned by a reader at a point of entry to the event associated with the ticket. This completes the transaction.

Mr. Mamdani’s Declaration also points out that, because of the inherent limitations of mobile devices, mobile device operating systems, and mobile web browser designs, at the time of this invention one of ordinary skill in the pertinent art would not have used 2D image codes for scanning from a wireless device, such as the Lewis PDA or the Hymel pager. Mamdani Declaration, at paragraph 8. That Declaration also explains that the subject matter of amended claims 1, 30 and 47-48 (use of a 2D image code to facilitate a complex wireless transaction where a first scan “partially” completes the wireless transaction and the second scan then

completes that transaction) has been commercially successful. As Mamdani explains, one such application is an airline boarding pass. In October 2007, the International Air Transport Association (IATA) announced a global standard for mobile bar codes to be used as airline boarding passes. In December 2007, the U.S. Transportation Administration (TSA) authorized a pilot program with Continental Airlines for mobile bar code check-in at Houston's Intercontinental Airport. In 2008, Continental, Delta, American, Northwest, and Alaska Airlines each introduced mobile bar code boarding passes at 11 major airports across the United States. Twenty percent (20%) of all airlines worldwide currently use mobile bar code boarding passes, a number that is expected to rise to 70%. A 2008 SITA survey found that thirty four percent (34%) of airline passengers prefer mobile boarding passes to use of paper. Earlier this year, the TSA announced that hand-held scanners will now be deployed in airports nationwide to facilitate these wireless transactions. As of the end of 2008, approximately one percent (1%) of all airline passengers worldwide use mobile boarding passes that include 2D image codes to facilitate a two-stage wireless transaction (a first scan of the device occurs at the security line and the second scan occurs at the departure gate). By the end of 2009, it is anticipated that 6% of all airline passengers worldwide will check in for their flights using this technique. Mamdani Declaration, at paragraphs 9-10.

Because Lewis/Hymel does not disclose the subject matter as a whole of any of claims 1, 30 and 47-48, these claims are patentable. Further, there is now objective evidence in this record that the claimed subject matter is commercially successful. Such evidence is highly probative of non-obviousness.

The rejection of claims 26-29, 31-33 and 45 under 35 U.S.C. § 103(a) as being unpatentable over Lewis, in view of Hymel and Ulvinen et al, U.S. Patent No. 6,393,305 is now believed to be moot. Claim 45 has been cancelled, and the dependent claims 26-29 and 31-33 are patentable for the reasons advanced with respect to their parent claims.

The Examiner is requested to reconsider the current rejections in view of the claim amendments.

**STATEMENT REGARDING THE SUBSTANCE OF THE INTERVIEW**

The Interview as conducted by telephone on February 3, 2009. During the Interview, the undersigned presented arguments why the Whitworth publication is not prior art. In addition, the undersigned explained the significant differences between 1D and 2D codes, as further outlined in Mr. Mamdani's Declaration. The undersigned also explained the multi-stage wireless transaction wherein there is a partial fulfillment of the transaction, followed by a completion of that transaction. The undersigned then discussed the deficiencies in the Lewis and Hymel references. A proposed claim amendment was submitted and discussed as well. The Examiner indicated that he would review the claim amendments upon their formal submission.

For the reasons set forth above, a Notice of Allowance is respectfully requested.

Respectfully submitted,  
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